

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS D. ANASTASIA, CHARLES M. ANASTASIA,
PETER J. BLOZNALIS, and ENGBERTUS BERKEL

Appeal No. 2000-1410
Application No. 09/021,667

ON BRIEF

Before BARRETT, GROSS, and LEVY, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, and 8. Claims 5 through 7 and 9 have been allowed. Claim 2 has been cancelled.

Appellants' invention relates to a gear recognition switch apparatus for vehicle transmissions. The apparatus includes an actuator with integral flexible members which restrict movement of the actuator to one of three mutually perpendicular directions, the direction of intended motion. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. Gear recognition switch apparatus for use in vehicular transmissions comprising

a housing having a bottom wall formed with an elongated channel therein along a longitudinal direction, the bottom wall having a platform surface on either side of the channel and having sidewalls extending upwardly from the bottom wall to form an actuator seat,

an actuator received on the actuator seat, the actuator having a base wall and manual valve coupling portion extending downwardly through the channel, the actuator formed with flexible portions which form an interference fit in the actuator seat with the actuator slidable along the platform surfaces in the longitudinal direction between first and second extremities of said elongated channel, said base wall of the actuator having opposed first and second ends in the longitudinal direction and opposed first and second sides in a lateral direction generally perpendicular to the longitudinal direction in which a flexible portion is formed by a longitudinally extending isolation slot formed in the base wall adjacent the first side thereof forming a flexible beam, said flexible beam having a protrusion thereon extending laterally outwardly,

a movable contact assembly disposed on top of the base wall, the movable contact assembly having at least one movable contact arm biased away from the base of the wall of the actuator, and

a stationary contact board received over the movable contact assembly and attached to the housing, the stationary contact board having at least one stationary contact path with an electrically conductive segment selectively positioned in a portion of the contact path, the at least one movable contact arm biased into engagement with at least one stationary contact path.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Suwa	4,441,000	Apr. 03, 1984
Tomotoshi	5,860,515	Jan. 19, 1999
		(filed May 28, 1997)

Claims 1, 3, 4, and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tomotoshi in view of Suwa.

Reference is made to the Examiner's Answer (Paper No. 15, mailed March 2, 2000) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 14, filed January 31, 2000) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1, 3, 4, and 8.

Appellants (Brief, pages 4-5) set forth two primary arguments against the examiner's proposed combination of Tomotoshi and Suwa -- that Suwa is non-analogous art and that neither Tomotoshi nor Suwa teaches or suggests a motivation for combining the two references. We agree with both of appellants' arguments.

As explained by appellants (Brief, page 4), Suwa is directed to a calculator, and thus from a different field of endeavor than appellants' invention, and is not reasonably pertinent to the particular problem with which appellants were concerned. Specifically, Suwa discloses projections for indicating switch positions and is not at all concerned with the problem of vibration isolation addressed by appellants' invention. The examiner states (Answer, page 4) that Suwa, Tomotoshi and

appellants' devices are all slide switches and are all used in moving environments which may produce unwanted vibrations. However, Suwa does not address the problem of unwanted vibrations and, therefore, does not meet either condition for analogous art.

Further, the examiner asserts (Answer, page 5) that there is sufficient motivation for combining the references. In particular, the examiner states that "it is well known that switches in moving environments work better and more consistently when there is structure present to secure the actuator and the contacts in the selected position. Suwa is an example of a well known structure, a beam with projections, that achieve such a result." Suwa, however, does not address the problem of securing the actuator and the contacts and, thus, fails to provide the necessary teaching or suggestion to use any disclosed structure in the device of Tomotoshi.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. ***Uniroyal, Inc. v. Rudkin-Wiley***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert.*

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denied, 488 U.S. 825 (1988). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, "[t]hat knowledge can not come from the applicant's invention itself." ***Oetiker***, 977 F.2d at 1447, 24 USPQ2d at 1446. As the examiner has pointed to no teaching, suggestion, or implication in the prior art that would have led the skilled artisan to modify Tomotoshi in the manner proposed by the examiner, no *prima facie* case of obviousness has been established. Accordingly, we cannot sustain the rejection of claims 1, 3, 4, and 8 under 35 U.S.C. § 103.

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CONCLUSION

The decision of the examiner rejecting claims 1, 3, 4, and 8 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
Administrative Patent Judge)	

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